REMARKS

In a restriction requirement dated June 19, 2009, the Examiner required restriction under 35 U.S.C. §§ 121 and 372 between:

> Group I, claim(s) 39-58 and 74-76, "drawn to a method."[1]
>
> Group II, claim(s) 59-73, "drawn to a fuel emulsion with detail of the fuel emulsion composition."

See Office Action at 2.

Applicants respectfully traverse the restriction requirement. However, to be fully responsive, Applicants elect, with traverse, the subject matter of Group I, comprising claims 39-58 and 74-76 identified by the Examiner as "drawn to a method for reducing emission of pollutants from an internal combustion engine." *Id.*

Applicants respectfully disagree and traverse the restriction requirement on the grounds that the Examiner has not met her burden to justify a restriction requirement.

First, Applicants respectfully refers the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P instructs the Examiner as follows:

> If the search and examination of all the claims in an application can be made **without serious burden**, the examiner **must** examine them on the merits, even though they include claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining Groups I and II together would constitute a serious burden. The Examiner contends that related Groups I and II can

[1] The Restriction additionally identifies claims 1-38 as members of Group 1; however, these claims were cancelled September 276, 2004.

also be distinct, but does not explain why a serious burden will be placed on the Examiner if she were to proceed in examining the groups together, as required by M.P.E.P. § 803. See Office Action at 2-3. First, the fact that the claims have different classifications does not mean there is a serious burden, given the overlap of the claims. In fact, by investigating Group 1, the Examiner will be forced to investigate every limitation in Group 2. Second, there is no basis for asserting divergent subject matter in view of the Examiner's own characterization of the two Groups. Third, significant overlap of the prior art should exist, particularly in view of the Examiner's own characterization of the two Groups. Fourth, the examiner has provided no basis for asserting "different non-prior art issues" may exist. Since every limitation of Group 2 is found in Group 1, there CANNOT be a serious burden upon the Examiner to examine both groups.

Second, under unity of invention (associated with national phase applications, such as this) Applicants are expressly permitted to prosecute both products claims and methods of use of product claims together in the U.S. M.P.E.P. § 1850(III)(A)(A) states that "[t]he method for determining unity of invention under PCT Rule 13 shall be construed as **permitting**, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application: . . . In addition to an independent claim for a given **product**, . . . and an independent claim for a **use** of the said product. . . ." (Emphasis added); *see also* 37 C.F.R. § 1.475(b)(2).

Third, the fact that unity of invention permits applicants to prosecute both apparatus and process claims together is further supported by the determinations of the

International Preliminary Examining Authority. Both in the June 7, 2004, International Preliminary Examination Report and in the February 10, 2004, Written Opinion, the IPEA conclusively determined that the pending claims possessed unity of invention.

Accordingly, Applicants submit that the Examiner's restriction requirement is improper and should be withdrawn in view of (1) failure to establish a burden, (2) misapplication of PCT Rule 13, and (3) repeated and contrary determinations of the IPEA.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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